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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/479,979	01/10/2000	WILLIAM HILL	13237-1701/M	3757

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 05/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/479,979

Applicant(s)

HILL ET AL.

Examiner

Cong-Lac Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: request for reconsideration filed 3/7/02 of application filed on 01/10/00 which is a continuation of the application 08/847,427 filed on 4/24/97, now US Pat No. 6,023,714.
2. Claims 35-53 are pending in the case. Claims 35, 42 and 48 are the independent claims.
3. The rejections of claims 35, 42-43, 48 under 35 U.S.C. 103(a) as being unpatentable over Shimizu have been withdrawn in view of applicants' arguments.
4. The rejections of claims 36-41, 44-47, 49-53 under 35 U.S.C. 103(a) as being unpatentable over Shimizu and further in view of Ferrel have been withdrawn in view of applicants' arguments.
5. The rejections of claims 35-53 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-11, 14 and 19 of U.S. Pat No. 6,023,714 have been withdrawn in view of the terminal disclaimer submitted by applicants.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 (c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 35-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spyglass Prism, *Concepts and Applications* (pages 1-8) and *Spyglass Prism 1.0* (pages 1-2), 3/1997 (referred as Spyglass) in view of Ferrel et al. (US Pat No. 5,860,073, 1/12/99, filed 7/17/95).

Note: the date of Spyglass Prism 3/97 is provided in the Spyglass documents cited in the previous office action.

Regarding independent claim 35, Spyglass discloses:

- determining a set of capabilities of the output device (Spyglass Prism, *Concepts and Applications*, page 2, once connected *the device identifies itself* and the user via the User Database used to track information such as user preferences and the *Device Database containing the characteristics of various devices* such as resolution,color or monochrome support, text or graphics display; Spyglass Prism 1.0, page 2, identifies the user and the device...run the content through the

series of conversion routines to convert the content into a format appropriate to that device)

- formatting the document for presentation on the output device (Spyglass Prism, Concepts and Applications, page 2, automatically massages Web content into a format that matches the capabilities of the requesting device)

Spyglass does not disclose selecting one of a plurality of style sheet based upon the set of capabilities of the output device.

Ferrel discloses that the style sheet is applied to individual display regions on pages within titles (col 3, lines 9-20). Ferrel also discloses formatting a HTML document using the style sheet, which is a collection of formatting, by allowing users to select an appropriate document layout to display a document instead of following the format of the tagged document (col 27, lines 36-55). Ferrel further discloses changing the presentation within the title based upon the output device characteristics (col 11, lines 36-60, based on the capabilities of the output device, the format of a document displayed of the laptop changes when the customer activates that document on the display of a computer, which is bigger).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Ferrel into Spyglass since Ferrel provides the style sheets for generating a document and the style sheet can be adapted for different output devices and Spyglass provides determining the capabilities of an output device connected to a computer. The combination of Ferrel into Spyglass would provide a method for formatting a document according to the style sheet that can be changed to

match the characteristics of the output device. In other words, said style sheet is selected based on the capabilities of the output device.

Regarding claim 36, which is dependent on claim 35, Spyglass does not disclose that a layout generator is used for determining a set of the capabilities of the output device and selecting one of a plurality of style sheets based upon the set of capabilities of the output device.

However, Spyglass does teach determining a set of the capabilities of the output device and Ferrel discloses selecting one of a plurality of style sheets based upon the set of capabilities of the output device (as mentioned in claim 35).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Spyglass and Ferrel to include a layout generator since said determining and said selecting, the functions of a layout generator, are performed in Spyglass and Ferrel.

Regarding claims 37, 44-45, 50, which are dependent on claims 35, 42, 48, respectively, Spyglass does not disclose that the layout generator is external to the document.

Ferrel discloses a method for formatting a HTML document using the style sheet, which is a collection of formats, that *allows users to select an appropriate document layout to display a document instead of following the format of the tagged document* (col 27, lines

36-55, figure 14). *Users can choose a desired style using the style sheet content dialog* (col 27, lines 36-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Spyglass to include the external feature to the document of the layout generator since modifying the style sheet is performed *outside* the document (*via the style sheet content dialog*).

Regarding claims 38-41, 46-47, 49-52, which are dependent on claims 35, 42, 48, respectively, Spyglass does not disclose embedding the style sheet in the document, placing a style tag corresponding to the selected style sheet in the document, wherein the document includes a plurality of tags and embedding the selected style sheet comprises placing style attributes corresponding to the selected style sheet in the tags of the document.

Ferrel discloses that the style sheet is embedded in the document, the style sheet comprises a style tag corresponding to the selected style sheet in the document, and the document includes a plurality of said tags (figure 14, style sheets A and B; col 33, lines 47-53, styles HEADING and PARAGRAPH are embedded in the document with the tag <H1>, </H1>, <P>, </P>, <H2>, </H2>).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Ferrel into Spyglass to provide more tools for manipulating a document for matching the capabilities of the output device applying the style sheets of documents.

Independent claim 42 includes limitations of claim 35, and is rejected under the same rationale except the limitations: selecting *a layout generator* and generating the selected style sheet based upon the set of capabilities of the output device *using the layout generator*.

Spyglass discloses automatically massaging web content into a format that matches the capabilities of the requesting device (Concepts and Applications, page 2).

Ferrel discloses the style sheet applied to individual display regions on pages within titles (col 3, lines 9-20) and provides the advantage that the format within a title of a document can be adapted for different output devices (col 11, lines 36-60, the presentation changes when displayed on a laptop or a computer).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Ferrel into Spyglass for obtaining a method of formatting a document that matches the capabilities of the output device using the style sheet selected based upon the set of capabilities of the output device.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Ferrel and Spyglass to incorporate selecting a layout generator for generating the selected style sheet based upon the set of capabilities of the output device. The fact that the format of a web document is manipulated to match the capabilities of the output device and the style sheet of a document, which is merely the format, can be adapted for different output devices show that the style sheet of the document is selected for matching the capabilities of the output device. In other words, generating the selected style sheet based upon the capabilities of the output device is inherently performed in adapting the format of web documents to different output devices as the function of the layout generator.

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Regarding claim 43, which is dependent on claim 42, as mentioned in claim 42, Spyglass and Ferrel do not explicitly disclose that the layout generator is a general purpose layout generator for use with a plurality of documents.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Spyglass and Ferrel to include a general purpose layout generator since Spyglass and Ferrel provide *adapting the style sheet for a plurality of documents* for matching the capabilities of different output devices. This shows that the style sheet is generated for a general purpose.

Regarding independent claim 48, the claim includes the limitations as in claims 35 and 42 except interrogating the output device to determine a set of capabilities of the output device. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Spyglass and Ferrel to add interrogating the output device to determine a set of capabilities of the output device since said interrogating is inherently included in "determining a set of capabilities of the output device" which is mentioned in claim 35. The reason is that the system should question the output device to find out the capabilities the output device has.

Regarding claim 53, Spyglass and Ferrel disclose that the document is a markup language document (Spyglass, Concepts and Applications, page 2, ..messages Web content into a format...; Ferrel, figure 14).

Response to Arguments

9. Applicant's arguments with respect to claims 35-53 have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue that Shimizu does not disclose determination of the capabilities of an output device so that the style sheet could be selected so that the document could be formatted.

Examiner agrees.

SpyGlass Prism discloses *determining the capabilities of the output device* (Spyglass Prism, Concepts and Applications, page 2, once connected *the device identifies itself* and the user via the User Database used to track information such as user preferences and the *Device Database containing the characteristics of various devices* such as resolution,color or monochrome support,

text or graphics display; Spyglass Prism 1.0, page 2, identifies the user and the device...run the content through the series of conversion routines to convert the content into a format appropriate to that device).

Ferrel discloses that the style sheet is applied to individual display regions on pages within titles (col 3, lines 9-20). Ferrel also discloses formatting a HTML document using the style sheet, which is a collection of formatting, by allowing users to select an appropriate document layout to display a document instead of following the format of the tagged document (col 27, lines 36-55). Ferrel further discloses selecting a style sheet based upon the output device characteristics (col 11, lines 36-60, based on the capabilities of the output device, the style sheet of a document displayed of the laptop

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sheet for generating a document and the style sheet can be adjusted for different output devices and Spyglass provides determining the capabilities of an output device connected to a computer. The combination of Ferrel into Spyglass would provide a method for formatting a document according to the style sheet that can be changed to match the characteristics of the output device. In other words, said style sheet is selected based on the capabilities of the output device.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Azima (US Pat No. 6,252,676B1, 6/26/01, filed 6/3/98, priority filed 6/4/97).

Bickmore et al., Digestor : Device Independent access to the World Wide Web, IEEE, 1997, pages 1075-1082.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong Lac Huynh whose telephone number is (703) 305-0432. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. The fax number to this Art Unit is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7239, (for formal communications intended for entry)

Or:

(703) 746-7240 (for informal or draft communications, please label

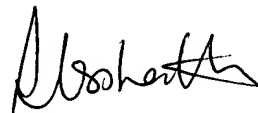
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

clh

5/16/02



STEPHEN S. HONG
PRIMARY EXAMINER